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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09,764,688	01/16/2001	Mary Ann Fitzmaurice	40655.0100	6906

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EXAMINER

LE, UYEN CHAU N

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,688

Applicant(s)

FITZMAURICE ET AL.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 23-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Requesting Continued Examination (RCE)

1. Receipt is acknowledged of the Requesting Continued Examination (RCE) field 02 December 2002.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 20, 23-27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masaki (JP 08-244,385) in view of Gunn (US 5,308,121).

Re claims 20, 23-27 and 29, Masaki discloses a multiple-service card 1 associated with which there is a service partner (e.g., university if used as a student ID card, a business-firm if

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used as a personnel certificate, or a club/department if used as a membership card, etc.), a primary party (DNP) and a holder, the card 1 comprising a first side 1b and a second side 1a, the first side 1b having a first indicia associated with the primary party, the second side 1a having second indicia associated with the service partner, which is a provider of membership club services (English abstract and detailed description, paragraph [0008], the second indicia including a service partner membership member, a magnetic strip 2a that contains account information in machine readable form, an image of the card holder (see figs. 1a & 1b; English translation: abstract and paragraph [0008] through paragraph [0011])).

Masaki fails to teach or fairly suggest that the primary party is a provider of credit services and the service partner is a provider of membership club services.

Gunn teaches the above limitation with the credit/service card companies (which serves as the primary party) offer a combination of services (which serves as the service partner) to be used with the credit card (e.g., automobile club membership, etc.) (see col. 2, lines 11-42), wherein the card having an expiration date 38 and a space for a signature 56 (see fig. 5).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Gunn into the teachings of Masaki in order to provide Masaki with a more profit system wherein the credit card companies work with the service partners to provide user the most convenient way of saving money due to the complimentary given for using the card. In addition, combining the functions and benefits of many different cards into a single card may alleviate the need of carry multiple cards, thus attracting more people to use the credit/service card; and therefore, the credit card companies and service partners will be appreciated because they make more profit. Furthermore, such

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modification would provide Masaki with a more secure system wherein the signature of the card holder can be verified (i.e., by comparing the signature on the card and the signature on the receipt), and the date of expiration to prevent fraudulent user of the card. Accordingly, such modification would have been an obvious extension as taught by Masaki, and therefore an obvious expedient.

5. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackenthun (US 5,969,318) in view of Gunn and Masuda (US 5,569,897). The teachings of Gunn have been discussed above.

Re claims 1-19, Mackenthun discloses a method of providing a multiple-service card. The method comprises the steps of receiving an application for a multiple-service card from a consumer 10; communicating/transmitting the credit card information to a provider of credit services [40A-40I]; causing a multiple-service card to be sent to the consumer by the card manufacturing apparatus [22, 23]. Request a card administrator 30; the card administrator 30 communicating with a card service engine [40A-40I]; the card service engine [40A-40I] communicating with card generator [22, 23]; the card generator [22, 23] communicating with the card administrator 30; the administrator 30 communicating with the consumer 10 for confirmation (figs. 1-6; col. 4, line 30 through col. 10, line 54).

Mackenthun fails to teach or fairly suggest the provider of credit services determine whether or not it desires to extend credit to the consumer.

Gunn teaches the above limitation with the credit/service card companies (which serves as the provider of credit services or primary party) offer a combination of services (which serves

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as the service partner) to be used with the credit card (e.g., automobile club membership, etc.) (see col. 2, lines 11-42).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Gunn into the teachings of Mackenthun in order to provide Mackenthun with a more secure system, wherein the credit/service card company (which serves as the provider of credit services or primary party) is the one who offers other services to the card user; therefore, it is obvious that the credit card company/service or the primary party determine whether or not to extend credit or to offer the requested services to the user. Accordingly, such modification would have been an obvious extension as taught by Mackenthun, well within the ordinary skill in the art, and therefore an obvious expedient.

Mackenthun as modified by Gunn fails to teach or fairly suggest the method of receiving at a service partner establishment an application and the service partner information related at least in part to membership in the service partner establishment.

Masuda teaches the above limitation with an application, which is filled by the user/consumer, is received through the retail store/service partner (col. 1, lines 20-25).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Masuda into the teachings of Mackenthun/Gunn in order to provide Mackenthun/Gunn with a more convenient system wherein the user can apply for a primary/secondary credit/membership/service card through a retail store/an establishment and knowing the approval result right away, he/she does not have to concern about forgetting to put the application in the mail or misplacing it and does not have to wait (with wonder) for the result, thus providing a more user-friendly system. Furthermore, such

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modification would have been an obvious extension as taught by Mackenthun/Gunn, and therefore an obvious expedient.

6. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masaki as modified by Gunn as applied to claim 20 above, and further in view of Blank (US 6,089,611). The teachings of Masaki as modified by Gunn have been discussed above.

Re claim 28, Masaki/Gunn has been discussed above but fails to teach or fairly suggest a barcode representing a service partner membership number.

Blank teaches the above limitation with barcode 22 representing a service partner membership number (fig. 1b; col. 5, lines 40+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Blank in order to provide Masaki/Gunn with a more organized and secure system wherein the system can keep track on the number of customers of each individual service partner. Furthermore, such modification would provide Masaki/Gunn with the capability of determining whether or not a valid member (i.e., by reading the membership number). Accordingly, such modification would have been an obvious extension as taught by Masaki/Gunn, and therefore an obvious expedient.

Response to Arguments

7. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

Newly cited references to Gunn and Masuda were used to meet the newly added limitations in amended claims.

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Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patent to Hulett is cited as of interest and illustrate a similar structure to multiple service card system.

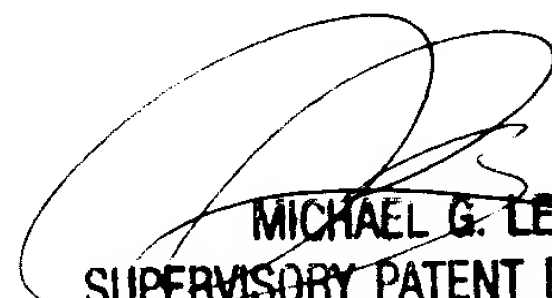
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M,T, F: 6:00-6:30 and W&TH: 9:00-11:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


Uyen-Chau N. Le

January 13, 2003


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800